



Patent Application Number: 09/396,175

Attorney Docket Number: MIT 7238

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AUG 22 2006

OFFICE OF PETITIONS

APPLICANT: Joseph G. DESLOGE

GROUP: 2634

SERIAL NUMBER: 09/396,175

EXAMINER: L. Jiang

FILED: September 14, 1999

FOR: LOCATING-ESTIMATING, NULL STEERING (LENS) ALGORITHM FOR
ADAPTIVE ARRAY PROCESSING

Box: Petitions

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Sir:

**RENEWED PETITION TO REVIVE AN UNINTENTIONALLY ABANDONED
APPLICATION UNDER 37 C.F.R. 1.137(b)**

The Applicant respectfully requests the Honorable Commissioner to grant this Petition under 37 C.F.R. 1.137(b) and revive the unintentional abandoned above-identified application in view of the facts and reasons set forth below.

CERTIFICATE OF MAILING (37 CFR 1.8(a))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United State Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450. Mail Stop: Petitions

Elizabeth M. Ball

(Type or print name of person mailing letter)

Date: 8-16-06


(Signature of person mailing paper)

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Statement of Facts

OFFICE OF PETITIONS

1. On December 21, 2001, the US Patent Office mailed a Quayle Action to the Applicant's Representative.

2. The Applicant's Representative received the Quayle Action dated December 21, 2001. (See copies of the Applicant Representative's Docket Records, filed with Petition Dated February 4, 2005, for the Months of February 2001 to July 2001 evidencing receipt of the Quayle Action dated December 21, 2001.)

3. On August 27, 2002, the US Patent Office mailed a Notice of Abandonment indicating that the above-identified application had been abandoned for failing to response to the Quayle Action dated December 21, 2001. The Applicant's Representative apparently never received the Notice of Abandonment mailed August 27, 2002. (See copies of the Applicant's Docket Records, filed with Petition Dated February 4, 2005, for the month of September 2002.)

4. On or about September 9, 2003, while researching another docket matter relating to an unintentional abandonment, Mr. Patrick J. O'Shea (Registration Number 35,305) examined his docket records to determine if any other cases assigned to Mr. O'Shea had unintentionally gone abandoned. As a result of this examination, Mr. O'Shea, the attorney handling the above-identified application (as evidenced by the copy of Official Filing Receipt, filed with Petition Dated February 4, 2005, identifying Mr. O'Shea as the attorney responsible for handling the correspondences for the above-identified application), determined that the above-identified application had gone abandoned.

5. On September 13, 2003, Mr. O'Shea mailed, with a Certificate of Mailing, a Petition to Revive under 37 C.F.R. 1.137(b). (See copy of mailed Petition, filed with Petition Dated February 4, 2005, with Certificate of Mailing.)

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6. On September 3, 2004, Mr. O'Shea filed a Power to Inspect for the above-identified application to determine if the Petition of September 13, 2003 had been received and/or acted upon by the US Patent Office.

7. On or about September 8, 2004, Mr. O'Shea's informed the undersigned that the US Patent Office never received the Petition of September 13, 2003. The undersigned then instructed Mr. O'Shea to immediately file a subsequent Petition. Mr. O'Shea indicated that he would handle the matter.

8. On December 31, 2004, Mr. O'Shea's partnership with Gauthier & Connors was severed.

9. On January 3, 2005, the undersigned, in going through the files left in Mr. O'Shea's office, discovered that Mr. O'Shea had failed to file the subsequent Petition as instructed by the undersigned on or about September 8, 2004.

10. On January 28, 2004, the attached Declaration was sent to Mr. O'Shea for his execution. Mr. O'Shea has refused to execute the attached Declaration.

11. On February 4, 2005, the undersigned filed a Petition under 37 C.F.R. 1.137(b) to revive the abandonment of the above-identified application.

12. On August 4, 2006, the Petitions Examiner dismissed the Petition for failing to provide language which specifically tracks 37 C.F.R. 1.137(b)(3), notwithstanding the fact that the undersigned provided an extension showing and explanation demonstrating that the requirement of 37 C.F.R. 1.137(b)(3) had been properly met.

REMARKS

The above-identified application has been unintentionally abandoned. Moreover, the entire delay in filing the required reply to the Quayle Action, dated December 21, 2001, from the due date for the reply (February 21, 2002) until the filing of a grantable petition pursuant to 37 C.F.R. 1.137(b) was unintentional.

Declaration

A newly executed Declaration was filed with the Petition dated February 4, 2005, as required by the Quayle Action dated December 21, 2001. The Honorable Commissioner is respectfully requested to accept the Declaration filed with the Petition dated February 4, 2005 to satisfy the requirements of 37 C.F.R. 1.137(b).

Formal Response

A Formal Response to the Quayle Action dated December 21, 2001, correcting the Abstract and the Specification, was filed with the Petition dated February 4, 2005, as required by the Quayle Action dated December 21, 2001. The Honorable Commissioner is respectfully requested to accept the Formal Response filed with the Petition dated February 4, 2005 to satisfy the requirements of 37 C.F.R. 1.137(b).

Substitute Specification

A Substitute Specification of the originally filed specification, pursuant to 37 C.F.R. 1.125(a), was filed with the Petition dated February 4, 2005, as required by the Quayle Action dated December 21, 2001. The Honorable Commissioner is respectfully requested to accept the Substitute Specification filed with the Petition dated February 4, 2005 to satisfy the requirements of 37 C.F.R. 1.137(b).

Evidence Showing Non-Receipt of Notice of Abandonment

It was at the time of mailing of Quayle Action, and still is the policy of Gauthier & Connors, to review all incoming mail and immediately docket all incoming correspondences from the US Patent Office. It was at the time of mailing of the Notice of Abandonment, and still is the policy of Gauthier & Connors, to immediately docket all incoming Notices from the US Patent Office concerning Abandonment for resolution within thirty days.

The Applicant's Representatives have attached the docket records of the Applicant's Representatives for the period of February 2001 to July 2001. The period of February 2001 to July 2001 demonstrates any due dates relating to correspondences from the US Patent Office having a mail date from November 2000 to June 2001 that were received by the Applicant's Representatives.

The Applicant's Representatives have also attached the docket records of the Applicant's Representatives for the period of September 2002. The period of September 2002 demonstrates any due dates relating to correspondences from the US Patent Office having a mail date from June 2002 to August 2002 that were received by the Applicant's Representatives.

As evidenced by the docket records of the Applicant's Representatives for the period of February 2001 to July 2001, the Applicant's Representatives received the Quayle Action December 21, 2001. On the other hand, the docket records of the Applicant's Representatives for the period of September 2002 clearly show no entries evidencing the receipt of a Notice of Abandonment relating to the above-identified application.

If the Notice of Abandonment, mailed August 27, 2002, had been received by the Applicant's Representatives, the Notice of Abandonment would have been docketed for a Response within thirty days (September 26, 2002). The docket records for the period of September 2002 clearly show no entries for a Notice of Abandonment relating to the above-identified application.

Explanation for Failing to Response to the Quayle Action dated December 21, 2001

The undersigned has thoroughly reviewed the undersigned's law firm's paper and electronic files for the above-identified application and has found no evidence that the Applicant desired to abandon this allowed application.

It was the policy of the undersigned's law firm at the time of filing the above-identified application, and it is still the policy, that the correspondence address, provided to the US Patent Office, designate the attorney responsible for that client as the primary contact person although another attorney or partner in the firm will actually be responsible for performing the actual work in preparing and/or prosecuting the application. This policy was established to prevent activities by associates and/or partners not responsible for the client from negatively impacting the client as well as safeguarding the docketing procedures of the undersigned's law firm. As explained below, but for the failure of Mr. O'Shea to follow the policy described above, the above described policy has successfully safeguarded the docketing process of the undersigned's law firm.

It was the policy of the undersigned's law firm at the time of filing the above-identified application, and it is still the policy, that all incoming correspondences from the US Patent Office are given to the attorney named as the primary contact in the correspondence address. It is the responsibility of the attorney named as the primary contact in the correspondence address to process the correspondence and properly docket the correspondence on both the docket of the attorney responsible for that client and the docket of the attorney actually handling the matter. The policy of designating the attorney responsible for that client as the primary contact person was implemented to ensure that the attorney ultimately responsible to the client was aware of all the activities associated with the client. As explained below, but for the failure of Mr. O'Shea to follow the policy described above, the above described policy has successfully safeguarded the docketing process of the undersigned's law firm.

With respect to the above-identified application, Mr. O'Shea failed to follow the policies of the undersigned's law firm at the time of filing the above-identified application by naming himself as the primary contact in the correspondence address. Mr. O'Shea's failure to follow policy prevented the safeguards of the policies the undersigned's law firm associated with docketing from being realized.

The undersigned was, at the time of filing the above-identified application, and still is the attorney responsible for the client associated with the above-identified application. Mr. O'Shea's failure to follow the policies of the undersigned's law firm, by designating himself as the primary contact person at the time of filing the above-identified application, prevented the undersigned from properly monitoring and supervising the overall prosecution of the above-identified application.

Notwithstanding the fact that Mr. O'Shea willfully breached the policies of the undersigned's law firm by designating himself as the primary contact in the correspondence address, Mr. O'Shea has refused to sign a declaration to provide evidence that Mr. O'Shea was the attorney responsible for handling the prosecution of the above-identified application and to provide evidence that Mr. O'Shea, in accordance with Mr. O'Shea's conversations with the undersigned, does not recall informing the Applicant of the Quayle Action and the need to response to avoid abandonment of the Application.

It was the policy of the undersigned's law firm at the time of the mailing of the Quayle Action, and still is the policy, to forward all Office Actions to the client with a cover letter explaining the Office Action and the suggested course of action going forward. After a thorough review of the Firm's paper file for the above-identified application and electronic records of the undersigned's law firm, the undersigned could not find any evidence that this letter was ever generated or forwarded to the Applicant.

The failure to properly respond to the Quayle Action dated December 21, 2001 was due to solely the actions of Mr. O'Shea, wherein these actions were not authorized by the Applicant.

In view of the evidence showing that a letter informing the Applicant of the Quayle Action was never sent, the Applicant was never aware of a pending Office Action that required a Response. Moreover, Mr. O'Shea's failure to respond to the Quayle Action was not authorized

by the Applicant. Since the Applicant did not know of the need to respond to the outstanding Quayle Action and the Applicant did not authorize the abandonment of the above-identified application, the Applicant could not form the requisite intent to abandon the above-identified allowed application.

Explanation for Delay in Realizing the Status of the Above-Identified Application

The Applicant was relying upon the Applicant's Representatives to monitor the progress of the Applicant's design application. As explained above, the Applicant's Representatives, due to Mr. O'Shea's failure to follow the policies of the undersigned's law firm, failed to realize that this application had become abandoned until an investigation in September of 2003 of all of Mr. O'Shea's matters, the investigation focusing upon files that did not have a correspondence from the US Patent Office for over a year, resulted in the discovery of this application having been abandoned for failure to response to the Quayle Action. The entire delay in discovering that this application had been abandoned for failure to response to the Quayle Action was unintentional.

Mr. O'Shea made an attempt to resolve this matter on September 13, 2003, but the Petition apparently was never received by the US Patent Office. During a subsequent investigation in September of 2004, Mr. O'Shea realized that the US Patent Office never received the September 2003 Petition. The entire delay in discovering that the US Patent Office never received the September 2003 Petition was unintentional.

Mr. O'Shea was instructed, by the undersigned, to immediately file a subsequent Petition. Mr. O'Shea acknowledged, to the undersigned, that he would immediately file the subsequent Petition.

Mr. O'Shea did not immediately file the subsequent Petition, as instructed by the undersigned. In view of the fact that that Applicant did not authorize the abandonment of the above-identified application and the undersigned's reliance that Mr. O'Shea had indicated that a subsequent Petition would be immediately filed, the entire delay associated with Mr. O'Shea's failure to file a subsequent Petition was unintentional.

The undersigned, upon going through the files left in Mr. O'Shea's office on January 3, 2005, discovered that Mr. O'Shea had failed to immediately file the subsequent Petition. The

entire delay in discovering that Mr. O'Shea had failed to immediately file the subsequent Petition was unintentional.

Therefore, the entire delay in filing the required reply to the Qualye Action, dated December 21, 2001, from the due date for the reply (February 21, 2002) until the filing of a grantable petition pursuant to 37 C.F.R. 1.137(b) was unintentional.

Dismissal of Petition Dated February 4, 2005

As noted above, on February 4, 2005, the undersigned filed a Petition under 37 C.F.R. 1.137(b) to revive the abandonment of the above-identified application. In this Petition, the undersigned provided an extension showing and explanation demonstrating that the requirement of 37 C.F.R. 1.137(b)(3) had been properly met.

Notwithstanding the extension showing and explanation demonstrating that the requirement of 37 C.F.R. 1.137(b)(3), namely that the entire delay in filing the required reply to the Qualye Action, dated December 21, 2001, from the due date for the reply (February 21, 2002) until the filing of a grantable petition pursuant to 37 C.F.R. 1.137(b) was unintentional, the Petitions Examiner, after failing to issue a decision on the Petition of February 4, 2005 for eighteen (18) months, dismisses the Petition for failing to provide language which specifically tracks 37 C.F.R. 1.137(b)(3).

As set forth above, the undersigned has clearly set forth language that specifically tracks the language of 37 C.F.R. 1.137(b)(3). More specifically, the undersigned has clearly that the entire delay in filing the required reply to the Qualye Action, dated December 21, 2001, from the due date for the reply (February 21, 2002) until the filing of a grantable petition pursuant to 37 C.F.R. 1.137(b) was unintentional.

SUMMARY

The Applicant did not intend to abandon nor delay the prosecution of the above-identified application because the Applicant's Representatives did not receive the Notice of Abandonment. Moreover, the Applicant did not intend to abandon nor delay the prosecution of the above-identified application because the Applicant relied upon the undersigned to monitor the progress of the Applicant's application and to inform the Applicant when action was required to maintain the pendency of the application. The undersigned was prevented from properly monitoring the progress of the Applicant's application as a result of Mr. O'Shea's failure to follow the policies of the undersigned's law firm. The Applicant was not aware that the Quayle Action had not been received nor that action was needed to gain issuance of the above-identified application. Lastly, the Applicant did not authorize Mr. O'Shea or the undersigned to abandon the above-identified application.

In conclusion, the Applicant should not be penalized due to the actions of Mr. O'Shea. The Applicant did not intend to abandon nor delay the prosecution of the above-identified application. Moreover, the entire delay in filing the required reply to the Quayle Action, dated December 21, 2001, from the due date for the reply (February 21, 2002) until the filing of a grantable petition pursuant to 37 C.F.R. 1.137(b) was unintentional.

Accordingly, in view of all the reasons set forth above and the attached evidence, the Honorable Commissioner is respectfully requested to grant the Petition to Revive under 37 C.F.R. 1.137(b).

Respectfully submitted,



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